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Supreme Court U.S.
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No. 02-487

IN THE

Supreme Court of the United States

JOSEPH A. GENTILUOMO,

Petitioner

v.

BRUNSWICK BOWLING AND BILLIARDS CORPORATION
(Individually and doing business as Brunswick Technology Ventures)
and as Quantum
and
Columbia 300, Inc.
(Individually and doing business as Track, Inc.)
and
Pin Breaker, Inc

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY

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REPLY TO RESPONDENT BRUNSWICK'S BRIEF

POINT 1: OBVIOUSNESS AND PRIOR ART

Respondent Brunswick Bowling and Billiards Corporation, ("Brusnwick") alleges the '614 patent ". . . is simply a bowling ball that has an inner core made from a material having a density that is higher than the density of its outer covering material." (B-1)[1] Brunswick presented no response disputing Petitioner Joseph A. Gentiluomo's ("Gentiluomo") arguments, effectively acknowledging them as factually correct. The Petition and Record, prove Brunswick's allegations are inaccurate and fallacious. Brunswick argues Gentiluomo was required to distinguish his '624 patent bowling ball from the "Randolph ball" in order to obtain the '614 patent.[2] (B-1) Gentiluomo complied with all relevant requirements and was granted the '614 patent.[3] Had he

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[1]References in ( ) marked "B- " refer to pages of Brunswick'srief received by counsel for Gentiluomo 10/28/02.

[2]Brunswick's allegations about the Randolph prior art ball are erroneous. Neither Court below relied on the specific gravity value of the Randolph ball in their decisions. Brunswick cannot cite any reference in the Courts' decisions where Randolph's specfic gravity of 1.219 teaches or suggests Gentiluomo's claimed specific gravity range of 1.195 to 0.38. Neither Court mentioned any specific gravity values of the cited prior art or how they supposedly were applied in rendering the '614 pat-ent obvious and invalid.

[3]Gentiluomo never conceded the only substantive difference between the elements claimed in the '096 patent were anticipated by the prior art. He never stated the patent claims at issue here was the range of density values. His amended claims more accurately set forth and included an upper specific gravity limitation of the encapsulating mass. It is not obvious to set values within the claimed ranges based on the Randolph and Fab I balls. The cited balls teach only of a fixed density value for the ball cover material, which is fixed at 1.213 for the Fab. I ball and 1.219 for the Randolph ball. A ball with a fixed specific gravity of 1.213 or 1.219 for the cover material cannot teach or suggest a lower specific gravity range of 1.195 to 0.38. A person of ordinary skill in the art, looking at the 1.213 and 1.219 values would not obviously arrive at the claim-

failed to properly and adequately comply, the U. S. Patent Office ("PTO") would not have issued the '614 patent. [SA-2-4][4] The PTO publishes "Manual of Patent Examining Procedure" ("MPEP")[SA], which includes a section captioned "700 Examination of Applications". MPEP cites the Code of Federal Regulations ('CFR") for the authority for its statements including support for rejection of Claims at 706 of MPEP. MPEP requires adherence to the "Uniform Application of the Patentability Standard."[SA-1 -8] Gentiluomo met his burden with the PTO.

Brunswick' statement concludes with its determination the Courts below correctly relied on the doctrine of obviousness, but neglects to address the fact that the Courts below failed apply the requirements of 35 U.S.C. §103 in evaluation of the claim. [SA-3, 5-8] Irah H. Donner in excerpts from *Patents*, in "Combating Obviousness Rejections Under 35 U.S.C. Section 103", 6 Alb. L .J. Sci. & Tech. 159 (1996)("Donner"), evaluates applicable standards in determinations on obviousness and prior art:

> "[T}he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . .we look to see whether combined teachings render the claimed subject matter obvious."[54]
>
> Because the obviousness standard requires prior art to teach, . . . failed experiments or inoperative inventions would not be considered prior art. . . . [I]t

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ed range of 1.195 to 0.38. Miller"s (4,522,397) and MacDonald's (4, 268,03414,353,850) prior art teach that the outer portion of a ball should be dense to increase the striking power, to select a ball cover specific gravity greater than the 1.213 value taught by the Fab I ball, and definitely not in Gentiluomo's claimed range of 1.195 to 0.38, as supported by his expert, establishing it as non-obvious.

[4]References SA-in [ ] are to Supplemental Appendix.

[54] *In re Wood*, 599 F2d 1032, 1037, . . . (CCPA 1979) (emphasis added)(citing *In re Bozek*, 416 F2d 1385, 1390, . . . (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322,. . .(CCPA 1964)).

> would appear that "non-enabling" inventions should not be considered prior art.[55] This issue currently remains undecided. . . . [S]ome decisions hold that "even unworkable devices can constitute prior art."[56] . . . [O]ther decisions hold that failed experiments, i.e., experiments that do not teach, are irrelevant as prior art and cannot be used in an obviousness rejection.[57]

Donner analyzed conflicting holdings, concluding in part:

> Obviousness cannot be established by combining teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.[95] Donner,

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[55] See, e.g., *Wilder*, 429 F.2d at 450 [429 F.2d 447] . . ..

[56] *Foseco Int'l Ltd.* v. *Cheminco, Inc.*, 507 F.Supp. 1253, 1260, . . . (E.D.Mich. 1981); see also *In re Shepard*, 172 F.2d 560. ..(CCPA 1949) . . . .[C]laims to be patentable must distinguish from the references even if the disclosures in the references are inoperative. *Shepard*, 172 F.2d at 563, . . . (citations omitted).

[57] "The "failed' experiment reported in the prosecution history. . .renders that patent irrelevant as a prior art reference. . . Judge Learned Hand [stated],"another's experiment, imperfect and never perfected will not serve either as an anticipation or as part of the prior art, for it had not served to enrich it.'"(citation omitted).

See *Ex parte Humphreys* 24 U.S.P.Q.2d (BNA) 1255, 1262 (BPAI 1992) ("We reverse this [Section 103] rejection . . . .[T]hose skilled in the art would not be enabled . . .to practice the methods called for by these claims throughout their scope."); . . .*United States* v. *Adams*,383 U.S. 39, 50, . . .(1966). . . ("An inoperative invention or one which fails to achieve its intended result does not negative novelty. . . . "*Id.* (citations omitted)).

[95] *Id. [ACS Hospital Systems, Inc.* v. *Montefiore Hospital*, 732 F.2d 1572] at1577. . . [929 (Fed. Cir. 1984)]. . .

at 184, see also 173-175, 180-182.

Clear division exists among Courts about what is and is not relevant and applicable as "prior art". This case fall squarely within this judicially tangled web. The Board of Patent Appeals and Interferences in *Ex parte Borden*, Appeal No. 97-4004, Application 08/459, 417, considered use of fluorescent material on certain surfaces and obviousness. Examining applicability of the teachings of prior art, the Board stated:

> Obviousness under §103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F2d 1071, 1073, . (Fed Cir 1988)) and the mere fact that. . . fluorescent apparel is known does not provide a sufficient factual basis for establishing the obviousness of the claimed fluorescent bowling shoes and wristband within the meaning of 35 USC §103 (see *In re GPAC Inc.*,57 F3d 1573, 1582, . .(Fed Cir 1995) and *In re Warner*, 379 F2d 1011, 1017 . .(CCPA 1967), *cert denied*, 389 U.S. 1957 (1968)). *Id.*p 11.

Donner, addressing the case of *Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992), set forth the relevant principle, "Oetiker's invention is simple. Simplicity is not inimical to patentablilty."[97],[5]

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[97] *Id.* at 1447. . . .

[5] Brunswick's claims of inconsistency are wrong. The declaration pertained to the 5,098,096 patent for which he filed a reissue application. Gentiluomo's statements regarding the claims of his '096 patent are not applicable or binding regarding the claims of his reissue patent Re. 34,614. Each claim is considered as setting for the complete and independent inventions. *Westwood Chemical, Inc.* v. *United States*, 186 USPQ 383 (U.S.Ct.). Each claim is treated as a separate patent; no two claims should be so construed as to make them identical. *Johns-Manville Corp.* v. *Italit, Inc.*,133 USPQ 228 (D. Ct. S.Fla). Gentiluomo's filed reissue application change the claims not to read on the prior art, and more precisely defined his claimed invention distinguishing it from Randolph and Fab I balls. Brunswick's arguments ignore the fact claims 24 and 32 taken as a whole definitely convey the fact that weight is design-wise removed from the outer to within the inner portion of the claimed ball, to

POINT II: FINALITY AND RULE 10

Brunswick's "aside" alleging Gentiluomo "fails to describe the procedural posture of the case"(B-2) apparently missed, skipped, or glossed over pages 3, 6 -8 of the Petition[6], detailing the procedural status of the case, including the remand of one of Gentiluomo's claims. The review sought at this point in time is not an "interlocutory review" (B-2); rather, it is an essential review authorized and required as a result of the dismissal of all but one of Gentiluomo's causes of action.

In *Lear, Inc.* v. *Adkins*, 395 U.S. 653, 89 S.Ct. 1902, (1969), this Court, considering the doctrine of license estoppel reviewed arguments that Adkins' improvements to the gyroscope did not warranted the award of a patent. This Court, reconsidering the doctrine of *Automatic Radio Mafg.Co.* v. *Hazeltine Research, Inc.*, 339 U.S. 827 (1950), the "*Hazeltine* rule", addressed patentability:

> The regulations do not require the Office to make a final judgment on an invention's patentability on the basis of the inventor's original application.[3] . . .[T]he Patent Office does not attempt to separate the wheat from the chaff on its own initiative. Instead, it rejects the application, giving the inventor the right to make an amendment . . .to cover only those aspects of the invention which are truly novel.[4]. . .[E]ven after an application is amended, the Patent Office finds that some of the remaining claims are unpatentable. When this occurs, the agency again issues a rejection which is subject to further amendment.[5] . . . [T]he process. . . continues until the Patent Office Examiner either grants a patent or concludes that none of the inventor's claims could possibly be patentable,. . .a final reje-

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increase the total kinetic energy output of a fixed weight ball.

[6]References in ( ) marked "G-"refer to Petition pages.

[3] 37 CFR §1.111 (1967)

[4] 37 CFR §1.106 (1967).

[5] 37 CFR §1.112 (1967).

ction is entered on the Office's records.[6] *Id.* 658.[SA-5-8]

While Adkins sought a patent on his invention, Lear claimed it "found a patent which it claimed fully anticipated Adkins' discovery." *Id.* at 659 The PTO issued Adkins a patent; he sued Lear on two types of gyroscopes. Lear claimed patent invalidity. The jury verdict for Adkins on one gyro, was set aside by the court finding "... Adkins' invention had been completely anticipated by the prior art.[9]" Both sides appealed. California Supreme Court qualified its conclusion stating:

> After noting Lear's claim that it had developed its .. gyros independently, the court tested this contention by considering "whether what is being built by Lear .. . springs *entirely*" (emphasis supplied) from the prior art. 67 Cal. 2d at 913, 435 P.2d, at 340. *Id.* at 661.

This Court, further stated:

> [T]he Supreme Court believed itself obligated to consider whether Adkins' ideas were not "entirely" anticipated by the prior art. 67 Cal.2d, at 913 . . . .Applying this test, the court upheld the jury's verdict .. finding that "Lear utilized the apparatus patented by Adkins throughout the period in question." 67 Cal. 2d, at 915, ... [T]he court did express its belief that Adkins' invention made a "significant step forward" in the art of gyroscopy. 67 Cal.2d, at 915, ... *Lear*, at 675-676.

Justice White, concurring in part, noted *Lear* did not present a "final" judgment. *Id.* at 679-680. Addressing the issues of juris-

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[6] 37 CFR §1.113 (1967).

[9] Adkins . . .second cause of action . . . contended that Lear had wrongfully appropriated a valuable trade secret . . . . The trial court . . . required Adkins to choose between his contract and tort claims. Since the California Supreme Court completely vindicated the inventor's right to contractual royalties, it was not obliged to consider the propriety of this aspect of the trial judge's decision. Consequently, the tort claim is not before us at this time.

diction from a "final" judgment of a state's highest court in *Lear*, the same jurisdictional issue applies here. Brunswick's argument that Gentilomo's case has not been entirely thrown out by the courts below not only is inaccurate, but it is a perversion of the truth. The Circuit Court's failure to afford Gentiluomo's invention the statutorily provided presumption of validity tainted the entire decision and distorted the resulting rulings premised on the federal questions presented. The manner in which the Courts below dismissed all of Gentilouomo's causes of action rendered those dismissals final and clearly reviewable at this time by this Court. See, *Lear, supra*, 395 U.S. 653.

In re Spormann, 363 F.2d 444 addressed rejection of a claimed invention by the PTO on the grounds of obviousness.

> . . .CCPA held that none of the cited references suggested the reduction . . . stat[ing]: . . . . *In re Adams*. . .the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.[149]
>
> Based on the above, the CCPA reversed the obviousness rejection.
>
> *Spormann* teaches that arguments based on "inherent" properties cannot stand when no supporting teaching exists in the prior art. Inherency and obviousness are distinct concepts. . . .[O]bviousness rejections based upon what may be inherent are improper. *Donner*, 201.

Considering invalidity, this Court stated:

> [T]o finally decide the case would require us to determine whether or not the apparatus as furnished was a direct infringement or mere contribution. But to do this would call for the exercise on our part of a duty which it was the province of the court below to perfo-

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[149] *Id. [Spormann]* at 448, . . . (citation omitted); see also *Dillon*, 919 F.2d at 688,. . . .

> rm and which doubtless it would have performed but for the error into which it fell. . . .We do not. . .stop to dispose of them since we are of the opinion that under the state of the record we ought not to do so but should leave them also to be considered for what they are worth by the court below, if duly presented and relied upon, when it comes hereafter to consider this controversy. *Marconi Wireless Telegraph Co. of Amer.* v *Simon*, 246 U.S.46, 57 1918).

The Courts' below errors leave this Court without a record on which the issues can be determined. The remaining cause of action remanded to the District Court by its nature will not and cannot address these issues, meaning that as to the other dismissed causes of action, no record can be made other than as is before this Court. Applying the tests and precedent of *Marconi*, it is both proper for this Court to grant certiorari, and necessary for resolution of the federal patent questions and to resolve the existing conflict among circuits concerning use of expert aid (G-27-29) as well as the failure of the Circuit to adhere to this Court's precedents in patent cases(G-22-27), especially in light of the Federal Circuits own holding in *CCS Fitness* v. *Brunswick Corporation*, 01-1139 (Fed.Cir May 3, 2002) addressed in the Petition, ignored by Brunswick. The Courts below completely dismissed causes of action on weight reallocation arguments and thereby also threw out all arguments premised on the significance attributed to the term "fixed weight ball" by Gentiluomo, rendering dismissal of all but the single cause of action "final".[7]

Justice Scalia's concurring opinion in *D.L. Thomas* v. *American Home Products, Inc.*, 519 U.S. 913. 117 S.Ct. 282, explained

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[7]A final order or judgment was entered by the Federal Circuit on the validity of all the '614 patent claims. The Circuit finally ruled that the invalidity of claims 24 & 32 was affirmed, and the invalidity of claim 45 was reversed. To consider validity of claims 24 & 32 separate from claim 45, would not serve to promote convenience or judicial economy, but would cause delay, expense and unnecessary complication

the "GVR mechanism"[8], and Rule 10 of this Court:

> "[P]etitioners' request for relief meets none of the tests set forth in our Rule 10, 'considerations governing review on writ of certiorari.'" . . . . [A]s this Court's Rule 10 itself makes plain, those tests "neither control nor fully measure the Court's discretion," but rather merely "indicate the character of the reasons the Court considers" in deciding whether to grant certiorari. . . . [W]e have never regarded Rule 10, which indicates the general character of reasons for which we will grant *plenary consideration*, as applicable to our practice of GVR'ing. . . . [*M*]*ost* of the cases in which we exercise our power to GVR plainly do not meet the "tests" set forth in Rule 10. (citations omitted)
>
> . . . [W]e are vacating the decision below to allow the court of appeals to reconsider an intervening decision of the court that is the final expositor of a particular body of law - - . . . . We assuredly would not decline to GVR a case affected by one of our intervening decisions merely because the case "is of no general importance beyond the interest of the parties." . . . .*D.L. Thomas*, at 519 U.S., __, 117 S.Ct., 283.[9]

POINT III: RELEVANCY OF THE LAW OF COMMERCIAL CARRIERS AND IRRELEVANT CITATION

Brunswick cited *Brotherhood of Locomotive Firemen & Enginemen* v. *Bangor & Aroostock Railroad Co.*, 389 U.S. 327, 88 S.Ct. 437, 19 L.Ed.2d 560 (1967) for purported lack of finality. It not only is distinguishable from this case, it is not even in the same "pew" much less the same "church". *Bangor & Aroostock*

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[8] "GVR mechanism" or grant of certiorari, vacating the judgment below and remanding for further proceedings in view of intervening developments.

[9] Act of September 24, 1789, c.20§14,1 Stat.81;Rev.Stat §716 empowering this Court "to issue all writs, not specifically provided for by statute, which may be necessary for the exercise of their respective jurisdictions, and agreeable to the usages and principles of law."

involved a TRO forbidding a strike, contempt orders, fines and application of the Norris-La Guardia Act. The legal issues and rules applicable to strikes of common carriers involve national safety and health and are accorded entirely different treatment than patent or any other cases. The unique nature of common carrier law in interstate commerce creates a singular system used by the courts in determining the applicability of specific laws. The decision addressed injunctive relief initially granted. This Court considered the unique nature of labor disputes and strikes of common carriers, determining the issues raised by the union were secondary to the underlying federal issues on which contempt was founded not yet addressed in the proceedings. *Bangor & Aroostock, supra,* is totally irrelevant to this patent case.

Haynes v *Jessop Steel,* 8 F.3d 1573 (Fed.Cir. 1993) cited by Brunswick, also is distinguishable. *Haynes* involved a claimed process where the prior art process identical with the exception of a difference in a claimed process temperature, chemical concentration, or a material element concentration, which is not comparable to the facts of this case. Gentiluomo's claimed structural process of manufacturing his claimed ball is different from the described process of manufacturing the cited prior balls and is further distinguishable from the prior art by the claimed structural, functional and process limitations related in claims 24 and 32 making *Haynes* inapplicable.

CONCLUSION

For the foregoing reasons, Gentiluomo's Petition for Certiorari should be Granted.

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